



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,603	02/22/2002	Masakatsu Kiwada	325772028100	8470

7590 09/20/2005

Barry E. Bretschneider  
Morrison & Foerster LLP  
2000 Pennsylvania Ave., N.W.  
Washington, DC 20006-1888

EXAMINER

MIRZA, ADNAN M

ART UNIT	PAPER NUMBER
----------	--------------

2145

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/079,603

Applicant(s)

KIWADA ET AL.

Examiner

Adnan M. Mirza

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 02/22/2002.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friday (U.S. 6,631,453) and Kenworthy (U.S. 6,317,837).

As per claims 1,13,17,22,28,36 Friday disclosed an image processing method for forming images on an image forming device based on a file stored in an image forming data transmission device using a portable terminal, said image forming data transmission device connected to a first internal network constructed inside a first firewall, said image forming device connected to a second internal network constructed inside a second firewall, and a file server connected to an external network constructed on the outside of said first firewall and said second firewall, comprising: a step (1) wherein said portable terminal establishes a connection with said image forming data transmission device via said second internal network, said second firewall, said external network, said first firewall and said first internal network using a protocol (col. 6, lines 14-41); a step (3) wherein said image forming data transmission device receives said image forming request transmitted by said portable terminal in the step (2) and prepares an image forming data for said file according to said image forming request; a step (4) wherein said image

Art Unit: 2145

forming data transmission device establishes a connection with said file server via said first internal network, said first firewall, and said external network using a protocol, which is allowed to make connections only from the internal network to the external network at said first firewall (col. 5, lines 42-66); a step (5) wherein said image forming data transmission device uploads said image forming data prepared in the step (3) to said file server; a step (6) wherein said image forming device establishes a connection with said file server via said second internal network, said second firewall, and said external network using a protocol, which is allowed to make connections only from the internal network to the external network at said second firewall: a step (7) wherein said image forming device download said image forming data from said file server; and a step (8) wherein said image forming device forms said image based on said image forming data downloaded in the step (col. 17, lines 48-67 & col. 18, lines 1-21).

However Friday did not disclose in detail “which is allowed to make bi-directional connections between the internal network and the external network at said first firewall and said second firewall; a step (2) wherein said portable terminal transmits an image forming request for said file stored in said image forming data transmission device to said image forming data transmission device”.

In the same field of endeavor Kenworthy disclosed, “In this way, the NADFW-MS 111 is able to screen a data packet based on particular network node from which the data packet was sent. This mechanism provides the NADFW-MS 111 with multi-directional access control (col. 8, lines 11-15).

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have incorporate, "In this way, the NADFW-MS 111 is able to screen a data packet based on particular network node from which the data packet was sent. This mechanism provides the NADFW-MS 111 with multi-directional access control" as taught by Kenworthy in the method of Friday to provide data secure environment for business to business computing.

3. As per claims 2,8 Friday-Kenworthy disclosed comprising between the step (5) and the step (6): a step (9) wherein said image forming data transmission device transmits a storage location data indicating where said image forming data uploaded in the step (5) is stored on said file server to said portable terminal; a step (10) wherein said portable terminal receives said storage location data which said image forming data transmission device transmitted in the step (9) (Friday, col. 4, lines 29-39); a step (11) wherein said portable terminal displays said storage location data received in the step (10); and a step (12) wherein said image forming device receives an entry of said storage location data; wherein said image forming device downloads said image forming data from the storage location on said file server based on said storage location data in the step (7) (col. 5, lines 50-65).

4. As per claims 3,9,33,35,37,39 Friday-Kenworthy disclosed comprising between the step (5) and the step (6): a step (9) wherein said image forming data transmission device transmits a storage location data indicating where said image forming data uploaded in the step (5) is stored on said file server to said portable terminal; a step (10) wherein said portable terminal receives

Art Unit: 2145

said storage location data which said image forming data transmission device transmitted in the step (9); a step (11) wherein said portable terminal displays said storage location data received in the step (10); and a step (12) wherein said image forming device receives an entry of said storage location data; wherein said image forming device downloads said image forming data from the storage location on said file server based on said storage location data in the step (7) (Friday, col. 18, lines 51-64).

5. As per claims 4,10,18,23,26,29 Friday-Kenworthy disclosed further comprising between the step (5) and the step (6): a step (15) wherein said file server transmits a storage location data indicating where said image forming data uploaded by said image forming data transmission device in the step (5) is stored on said file server to said portable terminal; a step (16) wherein said portable terminal receives said storage location data which said file server transmitted in the step (15) (Friday, col. 18, lines 38-49); a step (17) wherein said portable terminal displays said storage location data received in the step (16); and a step (18) wherein said image forming device receives an entry of said storage location data; wherein said image forming device downloads said image forming data from the storage location on said file server based on said storage location data in the step (7) (Friday, col. 18, lines 51-64).

6. As per claims 5,11,19,30 Friday-Kenworthy disclosed further comprising between the step (5) and the step (6): a step (15) wherein said file server transmits a storage location data indicating where said image forming data uploaded by said image forming data transmission device in the step (5) is stored on said file server to said portable 10 terminal; a step (16) wherein

Art Unit: 2145

said portable terminal receives said storage location data which said file server transmitted in the step (15) (Friday, col. 18, lines 38-49); a step (19) wherein said portable terminal transfers, said storage location data received in the step (16) to said image forming device via said second internal network or a local communication circuit; a step (20) wherein said image forming device receives said storage location data transferred by said portable terminal in the step (19); wherein said image forming device loads said image forming data from the storage location on said file server based on said storage location data in the step (7) (Friday, col. 18, lines 51-64).

7. As per claims 6,12,14,16,20,24,27,31 Friday-Kenworthy disclosed wherein said image forming device is a printer and said image forming data is a printing job (Kenworthy, col. 3, lines 19-21).

8. As per claims 7,15,21,25,32,34,38 Friday-Kenworthy disclosed an image processing method for forming an image on an image forming device based on a file stored in an image forming data transmission device using a portable terminal, said image forming data transmission device connected to a first internal network constructed inside a first firewall, said image forming device connected to a second internal network constructed inside a second firewall, and a file server connected to an external network constructed on the outside of said first firewall and said second firewall, comprising: a step (1) wherein said portable terminal establishes a connection with said image forming data transmission device via a public network, a public network authenticating server connected to said first internal network, and said first internal network; a step (2) wherein said portable terminal transmits an image forming request

Art Unit: 2145

for said file stored in: said image forming data transmission device to said image forming data transmission device (Kenworthy, col. 8, lines 11-15); a step (3) wherein said image forming data transmission device receives said image forming request transmitted by said portable terminal in the step (2) and prepares an image forming data for said file according to said image forming request; a step (4) wherein said image forming data transmission device establishes a connection with said file server via said first internal network, said first firewall, and said external network using a protocol, which is allowed to make connections only from the internal network to the external network at said first firewall; a step (5) wherein said image forming data transmission device uploads said image forming data prepared in the step (3) to said file server; a step ( 6) wherein said image forming device establishes a connection with said file server via said second internal network, said second firewall, and said external network using a protocol, which is allowed to make connections only from the internal network to the external network at said second firewall; a step (7) wherein said image forming device downloads said image forming data from said file server; and a step (8) wherein said image forming device forms said image based on said image forming data downloaded in the step (7) (Friday, col. 17, lines 48-67 & col. 18, lines 1-21).

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Adnan Mirza whose telephone number is (571)-272-3885.



Art Unit: 2145

10. The examiner can normally be reached on Monday to Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571)-272-3880. The fax for this group is (703)-746-7239.

11. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)-746-7239 (For Status Inquiries, Informal or Draft Communications, please label "PROPOSED" or "DRAFT");

(703)-746-7239 (For Official Communications Intended for entry, please mark "EXPEDITED PROCEDURE"),

(703)-746-7238 (For After Final Communications).

12. Any Inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-305-3900.

Any response to a final action should be mailed to:

BOX AF

Commissioner of Patents and Trademarks Washington, D.C.20231

Or faxed to:

Art Unit: 2145

Hand-delivered responses should be brought to 4<sup>th</sup> Floor Receptionist, Crystal Park II,  
2021 Crystal Drive, Arlington, VA 22202.

*AM*

Adnan Mirza

Examiner



RUPAL DHARIA  
SENIOR PATENT EXAMINER